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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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21005	7590	07/01/2004	EXAMINER	
HAMILTON, BROOK, SMITH & REYNOLDS, P.C.			MITCHELL, TEENA KAY	
530 VIRGINIA ROAD			ART UNIT	
P.O. BOX 9133			PAPER NUMBER	
CONCORD, MA 01742-9133			3743	

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/715,031	Applicant(s) E. ZAISER ET AL.	
	Examiner Teena Mitchell	Art Unit 3743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 17-20 is/are rejected.
- 7) ☒ Claim(s) 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

While applicant in the first paragraph of the specification notes that this case is a Divisional of application 09/342,953, the current status of this application should also be provided in the first paragraph. Correction is requested. It is noted by the examiner the applicant has filed this application as a Divisional, however, the examiner after reviewing the parent application 09/342,953, notes that no restriction was made in the parent application and thus the instant application should have been filed as a Continuation/Continuation in Part not a Divisional. Therefore, the Double Patenting Rejection, which follows is proper. Applicant is also required to correct the priority status from a Divisional to a Continuation application.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:
Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

A change in the address of Kevin Confov has been made, however no initials or date was provided. (note the lined through zip code).

Information Disclosure Statement

The examiner has reviewed all references listed in the parent application 09/342,953, however, should applicant desire the information to be printed on any patent that may issue from the instant application, applicant must submit an appropriate 1449 listing such references (note MPEP 609).

Claim Objections

Claim 8 is objected to because of the following informalities: In lines 6 and 7, "...a second coupling feature..." because applicant has not claimed a first coupling feature it is unclear as to why a second coupling feature is being claimed. Then in line 10, "...the coupling feature..." because it is unclear if a first and a second coupling feature are suppose to be claimed the limitation in line 10 makes it unclear as to which coupling feature is being claimed. Applicant should clarify if a first coupling feature is suppose to be claimed and if not why then is a second coupling feature being claimed in lines 6 and 7, should applicant claim a first and second coupling feature then in line 10, applicant needs to clarify which coupling feature is being claimed. Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5, 7-12, 14, 15, and 17-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims

1-3, 6,7, 11, 15, 21, 23, and 32 of U.S. Patent No. 6,647,982. Although the conflicting claims are not identical, they are not patentably distinct from each other because **Claim 1 of the instant application** discloses an outer body having an inner cavity formed therein (limitations found in claim 1 of the patent), the inner cavity bounded by an inner wall of the outer body (limitations found in claim 1, lines 5-10 of the patent), the inner wall having an orifice extending through the outer body (inasmuch as the inner core is secured to the outer body, it would be obvious that the inner wall has an orifice extending through the outer body and also the orifice would be inherently present for the flow of oxygen); an inner element within the cavity, the inner element having an external wall with a coupling feature, the coupling feature aligned with the inner wall (the limitation can be found in claim 7 of the patent); and a gas fitting extending through the orifice and coupling with the coupling feature (the limitations can be found in claims 1, 1-3 and 7 of the patent), the instant application claim 1 is merely broader than the patented claim 1 and has some features found in claims 2, 3, and 7 of the patent, therefore the patented claim 1 "anticipates" the application claim (In re Goodman, 11F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993). **Claim 2 of the instant application limitations** can be found in claim 1 and 11 of the patent. **Claim 3 of the instant application limitations** can be found in claim 6 of the patent. **Claim 4 of the instant application limitations** can be found in claim 6 of the patent (with respect to the language of "substantially" it would be obvious to one of ordinary skill in the art at the time the invention was made that if the inner element was made of brass the limitation of substantially made of brass would also be met by the language of claim 6 of the

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patent). **Claim 5 of the instant application** limitations can be found in claim 15 of the patent. **Claim 7 of the instant application** limitations can be found in claim 1 and 32 of the patent. **Claim 8 of the instant application** limitations can be found in claim 21 of the patent (the limitation of the second coupling would be a mere duplication of parts which would have been obvious to one of ordinary skill in the art). **Claim 9 of the instant application** limitations can be found in claim 21 of the patent. **Claim 10 of the instant application** limitations can be found in claim 6 of the patent (while claim 10 is a method claim the patent in claim 6 discloses the use of aluminum and therefore it would have been obvious to use an aluminum for the outer body). **Claim 11 of the instant application** limitations can be found in claim 6 of the patent. **Claim 12 of the instant application** limitations can be found in claim 25 of the patent. **Claim 14 of the instant application** limitations can be found in claim 21 of the patent. **Claim 15 of the instant application** limitations can be found in claims 32 and 34 of the patent. **Claim 17 of the instant application** limitations can be found in claim 35 of the patent. **Claim 18 of the instant application** limitations can be found in claim 36 of the patent. **Claim 19 of the instant application** limitations can be found in claim 32 of the patent. **Claim 20 of the instant application** limitations can be found in claim 37 of the patent.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

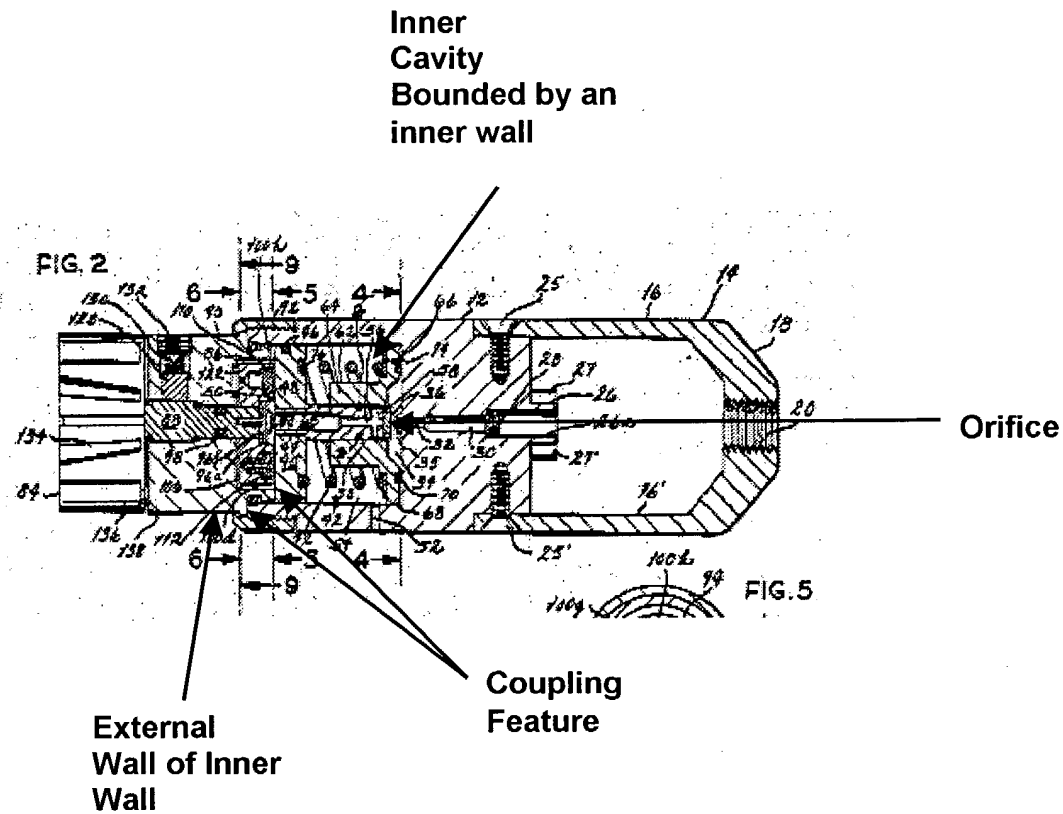
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 6, 8-10, 12, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Phlipot et.al. (4,655,246).

Phlipot in a gas flow device discloses:

- an outer body (12) having an inner cavity (see illustration of Fig. 2 below) formed therein, the inner cavity bounded by an inner wall of the outer body, the inner wall having an orifice extending through the body (See illustration of Fig. 2 below);
- an inner element (66,88,90) within the inner cavity (Fig. 2), the inner element having an external wall (see illustration of Fig. 2 below) with a coupling feature (see illustration of Fig. 2 below), the coupling feature aligned with the orifice (see illustration of Fig. 2 below) and
- a gas fitting (at 102) extending through the orifice (via 104 the gas fitting does extend through the orifice) and coupling with the coupling feature (note illustration of Fig. 2 below (threads), with respect to the language of the gas fitting coupling with the coupling feature, the examiner contends that inasmuch as the gas fitting is integral with the inner element it is inherently coupled with the coupling feature (see also Fig. 7).

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With respect to claim 2, Philpot discloses wherein the outer body (12) and the inner element (86,88,90) are of different materials (Col. 3, lines 59-62 and Col. 6, lines 1-7).

With respect to claim 3, Philpot discloses wherein the outer body (12) comprises aluminum (Col. 3, lines 59-62).

With respect to claim 5, Philipot discloses wherein the coupling feature includes matable threads (Fig. 2).

With respect to claim 6, Philipot discloses wherein the inner element is at least one of a pressure reduction element or a flowmeter (86,88,90; because these elements can adjust the flow of oxygen through the device they are a pressure reduction element or flowmeter).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 8, 9, 10, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Philipot (4,655,246).

With respect to claim 8 (as best understood by the examiner), Philipot discloses an outer body (12); an inner cavity in the outer body (see illustration of Fig. 2 above), the inner cavity bounded by an inner wall of the outer body (see illustration of Fig. 2 above); an orifice through the outer body to the inner wall (see illustration of Fig. 2 above); an inner element (86,88,90) having an external wall (see illustration of Fig. 2 above) with a second coupling feature (see illustration of Fig. 2 above); a gas fitting through the orifice (102). The claimed steps would have been obvious to one of ordinary skill in the art at the time the invention was made because they would have resulted from the use of the device of Philipot.

With respect to claim 9, Philipot discloses wherein the outer body (12) and the inner element (86,88,90) are of different materials (Col. 3, lines 59-62 and Col. 6, lines 1-7).

With respect to claim 10, Philipot disclose where in the outer body (12) comprises aluminum (Col. 3, lines 59-63).

With respect to claim 12, Phlipot discloses wherein the coupling feature includes matable threads (Fig. 2).

With respect to claim 13, Phlipot discloses wherein the inner element is at least one of a pressure reduction element or a flowmeter (86,88,90; because these elements can adjust the flow of oxygen through the device they are a pressure reduction element or flowmeter).

Claims 4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phlipot (4,655,246) in view of Chu (5,860,447).

The difference between Phlipot and claim 4 is the inner element formed substantially from brass.

Chu in a pressure regulator teaches body member can be made of any material sufficient to withstand the internal pressure that develops such as aluminum, steel, brass, bronze, or strong plastic and that the piston (i.e., inner element) can be machined, cast, or molded, from any material that will withstand the friction against the axial bore of the regulator body (Col. 4, lines 38-40 and 64-67).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use any well known material including brass for the inner element of Phlipot doing so would have provided a material which is able to withstand internal pressure and friction including the brass material taught by Chu. Because the device of Phlipot must be able to withstand internal pressure one of ordinary skill in the art would also look to brass for the inner element because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its

suitability for the intended use as a matter of choice (In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) and inasmuch as Chu teaches that brass is able to withstand internal pressure one of ordinary skill in the art would look to brass for the inner element because as gas flows through the orifice and into the inner element pressure changes are going on and brass would be able to withstand such pressure changes.

With respect to claim 11, note rejection of claim 3 above.

Allowable Subject Matter

Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The overall combination of the limitations of claim 15 wherein the fitting is a hose connector is neither anticipated nor rendered obvious by the prior art of record. While Phlipot does disclose a hose connector (102) the hose connector does not extend through the outer body and engage the inner core to secure the inner core to the outer body.

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The balance of art is cited to show gas flow devices: 6,523,565; 6,286,543; 6,082,396; 6,158,457; 6,082,359; 6,148,841; 5,890,512; 5,911,220; 5,413,096; 4,719,940; 4,256,138; 4,020,863.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Teena Mitchell whose telephone number is (703) 308-4016. The examiner can normally be reached on Monday-Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on (703) 308-0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Teena Mitchell
Examiner
Art Unit 3743
June 22, 2004